IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number:	10/685,192
Filing Date:	10/14/2003
Applicant(s):	Duncan L. Mewherter, Amy D. Travis, Koah-Hsing Wang and Robert C. Weir
Entitled:	RETRIEVING SLIDE SHOW CONTENT FROM PRESENTATION DOCUMENTS
Examiner:	Debrow, James J.
Group Art Unit:	2176
Attorney Docket No.:	LOT920030025US1 (7321-010U)

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellant's Appeal Brief in support of the Notice of Appeal filed February 14, 2008. As this Appeal Brief has been timely filed within the two-month shortened statutory period, no extension of time under 37 C.F.R. § 1.136 is required. Notwithstanding, please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account **12-2158**, and please credit any excess fees to such deposit account.

Date: April 8, 2008   Respectfully submitted,

/Steven M. Greenberg/
Steven M. Greenberg
Registration No. 44,725
Customer Number 46321

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APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed February 14, 2008, wherein Appellants appeal from the Examiner's rejection of claims 1 through 22.

I. REAL PARTY IN INTEREST

This application is assigned to International Business Machines Corporation by assignment recorded on October 14, 2003, at Reel 014611, Frame 0968.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1 through 22 are pending in this Application and have been twice rejected. It is from the multiple rejections of claims 1 through 22 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims were amended in the Amendment of September 5, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1 through 22 are respectively directed to a system, method and apparatus for converting a slide show presentation for use within a non-presentation application such as a Web conferencing or virtual classroom application. In Appellants' invention, a slide show presentation in its native format can be processed to extract slide title information for each slide in the slide show presentation. Additionally, important text within the slide further can be extracted. Each slide in the slide-show can be converted to a raster image and disposed within markup. The markup can be annotated with the important text and both the markup and the slide title can be provided to the non-presentation application for use in concert with the non-presentation application. In this way, the context of each slide can be preserved for use within the non-presentation application as can an image of each slide itself.

With reference to independent claim 1 and in accordance with the Appellants' invention, a system for converting slide show presentations for use within non-presentation applications can include a slide show (Figure 1, Element 120) produced by a slide show presentation application (Figure 1, Element 110) and stored in a native format (Page 10, lines 11-13). The system also can include a slide show conversion process (Figure 1, Element 200) configured for coupling to a non-presentation application (Figure 1, Element 150) and programmed both to extract contextual data (Figure 1, Element 130) from said slide show in its native format (Page 10, lines 11-13), and also to convert associated slides in said slide show to raster imagery (Figure 1, Element 140) for use in said non-presentation application (Figure 1, Element 150).

With reference to independent claim 6, a method for converting a slide show presentation can be provided for use within a non-presentation application. The method can include extracting a slide title for a first slide in a slide show presentation produced by a slide show presentation application (Figure 2, Block 220). The method also can include converting the first slide into a raster image. (Figure 2, Block 230) The method yet further can include disposing both the slide title and the raster image in a markup language document. (Figure 2, Blocks 235 and 240) Finally, the method can include repeating the extracting, converting and disposing steps for a selected group of other slides in the slide show presentation. (Figure 2, Blocks 255 through 260).

With reference to independent claim 16, a machine readable storage having stored thereon a computer program for converting a slide show presentation can be provided for use within a non-presentation application. The computer program can include a routine set of

instructions which when executed by a machine perform steps including extracting a slide title for a first slide in a slide show presentation produced by a slide show presentation application (Figure 2, Block 220), converting the first slide into a raster image (Figure 2, Block 230), disposing both the slide title and the raster image in a markup language document (Figure 2, Blocks 235 and 240) and repeating the extracting, converting and disposing steps for a selected group of other slides in the slide show presentation. (Figure 2, Blocks 255 through 260).

VI. ISSUES TO BE REVIEWED ON APPEAL

1.   Claims 1-4, 6, 7, 12, 14, 16 and 17 are not unpatentable under 35 U.S.C § 103(a) over U.S. Patent Application Publication No. 2002/0152234 by Estrada et al. (Estrada) in view of U.S. Patent Application Publication No. 2004/0194035 by Chakraborty.

2.   Claims 5, 8, 9, 15, 18, 19 and 22 are not unpatentable under 35 U.S.C § 103(a) over Estrada in view of Chakraborty and further in view of U.S. Patent Application Publication No. 2004/0202349 by Erol et al. (Erol).

3.   Claims 10, 11, 13, 20 and 21 are not unpatentable under 35 U.S.C § 103(a) over Estrada in view of Chakraborty and further in view of U.S. Patent No. 7,162,691 to Chatterjee et al. (Chatterjee).

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1-4, 6, 7, 12, 14, 16 AND 17 UNDER 35 U.S.C § 103(A) AS BEING UNPATENTABLE OVER ESTRADA IN VIEW OF CHAKRABORTY, THE REJECTION OF CLAIMS 5, 8, 9, 15, 18, 19 AND 22 UNDER 35 U.S.C § 103(A) OVER ESTRADA IN VIEW OF CHAKRABORTY AND FURTHER IN VIEW OF EROL, AND THE REJECTION OF CLAIMS 10, 11, 13, 20

For convenience of the Honorable Board in addressing the rejections, claims 2 through 5, 7 through 15 and 17 through 2 stand or fall together with independent claims 1, 6 and 16, respectively.

The combination of Estrada and Chakraborty fail to teach the extraction of contextual data from a slide show in its native format. Presently, claim 1 reads as follows:

> 1.   A system for converting slide show presentations for use within non-presentation applications, the system comprising:
>
> a slide show produced by a slide show presentation application and stored in a native format; and,
>
> a slide show conversion process configured for coupling to a non-presentation application and programmed **both to extract contextual data from said slide show in its native format, and also to convert associated slides in said slide show to raster imagery for use in said non-presentation application**.

The Appellant noted in page 10 of the Amendment of September 6, 2007 in response to the Non-Final Office Action dated June 5, 2007 that the combination of Estrada and Chakrabort failed to teach the extraction of contextual data from a slide show in its native format.

Specifically, the Appellant stated,

> The bolded and underlined portions are wholly absent in the combination of Chakraborty and Estrada. Chakraborty for its part entirely lacks any teaching relating to a "slide show", a "slide show presentation application", or a "slide". Rather, Chakraborty only teaches the extraction of text from a PDF when reading a PDF form. Estrada, in turn, teaches only the conversion of a slide in a slide show into an HTML document. In order to satisfy a prima facie case of obviousness under M.P.E.P. 2143, the Examiner must locate every recited element of the rejected claim in the references as cited. In this case, the Examiner has not located **the extraction of contextual data from said slide show in its native format**. Rather, the Examiner merely has located the extraction of data from a PDF file.

In response, the Examiner in the Final Office Action dated November 14, 2007 provided the counter-argument taken verbatim from M.P.E.P. 2145(III),

> In response to the applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on the combinations of the references.

Examiner's arguments are misguided, however, in that Examiner has not found the critical element "extraction of contextual data from said slide show in its native format".

By Examiner's reasoning, Examiner would only be required to find a reference that teaches "extraction", a different reference that shows "contextual data", and yet a different reference that shows "a slide show in a native format". Thereafter, according to Examiner's logic the Examiner would have proven a prime facie case of obviousness. This would be an absurd outcome and stands in contravention of the basic premise of obviousness set forth in the M.P.E.P. In fact, M.P.E.P. 2141(III) provides clear guidance, "The gap between the prior art and the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.', citing <u>Dann v. Johnston</u>, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976). *There is a gap in this instance.*

In this instance, the Examiner has admittedly only shown one reference (Estrada) that shows a slide show in general (See Page 3, Final Office Action) and another reference that shows the extraction of data from a PDF file (See Page 3, Final Office Action). The gap that exists is the <u>extraction of contextual data from a slide show in its native form</u>. The Examiner has provided no explanation of how one of ordinary skill in the art would have arrived at the extraction of contextual data from a slide show in its native form, when presented with only two publications: one publication teaching a slide show and the other publication teaching performing OCR on a PDF file.

M.P.E.P. 2141(II) specifically recommends

> When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

The Examiner, however, has not explained factually how one of ordinary skill in the art would have understood the teachings of Chakraborty and Estrada to arrive at Appellants' invention.

In view of the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. § 103(a) based upon the applied prior art are not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103(a).

Date: April 8, 2008   Respectfully submitted,

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VIII. CLAIMS APPENDIX

1.   (Original)   A system for converting slide show presentations for use within non-presentation applications, the system comprising:

        a slide show produced by a slide show presentation application and stored in a native format; and,

        a slide show conversion process configured for coupling to a non-presentation application and programmed both to extract contextual data from said slide show in its native format, and also to convert associated slides in said slide show to raster imagery for use in said non-presentation application.

2.   (Original)   The system of claim 1, wherein said contextual data comprises a slide title for each one of said associated slides.

3.   (Original)   The system of claim 1, wherein said contextual data comprises important text associated with each one of said associated slides.

4.   (Original)   The system of claim 1, wherein said slide show conversion process further comprises programming for generating a markup language document and for disposing said contextual data and said raster imagery within said markup language document.

5.   (Original)   The system of claim 1, wherein said slide show conversion process further comprises programming for reducing said raster imagery to a size suitable for display in a pervasive device.

6.   (Previously Amended)   A method for converting a slide show presentation for use within a non-presentation application, the method comprising the steps of:

extracting a slide title for a first slide in a slide show presentation produced by a slide show presentation application;

converting said first slide into a raster image;

disposing both said slide title and said raster image in a markup language document; and,

repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation.

7.   (Original)   The method of claim 6, further comprising the steps of:

further extracting important text from said first slide;

annotating said raster image of said first slide in said markup language document with said extracted important text; and,

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation.

8.   (Original)   The method of claim 6, wherein said further extracting step comprises the step of further extracting text having formatting characteristics within said first slide which emphasizes said text.

9.   (Original)   The method of claim 8, wherein said formatting characteristics comprise a point size which exceeds a threshold value.

10. (Original) The method of claim 7, wherein said annotating step comprises the step of generating an ALT tag with said important text in association with said raster image in said markup language document.

11. (Original) The method of claim 10, wherein said generating step further comprises the step of formatting said ALT tag with additional inline indicators for facilitating an audible playback of said important text in a non-presentation application.

12. (Original) The method of claim 6, further comprising the step of processing said markup language document in a non-presentation application.

13. (Original) The method of claim 12, wherein said processing step comprises the step of generating an agenda with each slide title for each raster image in said markup language document.

14. (Original) The method of claim 6, further comprising the step of performing each of said extracting, disposing, converting and repeating steps in externally to a slide show presentation application which produced the slide show presentation.

15. (Original) The method of claim 6, further comprising the steps of:
  reducing said raster image to a size suitable for display in a pervasive device; and,
  rendering said slide title and said reduced raster image in a pervasive device display.

16.   (Previously Amended)   A machine readable storage having stored thereon a computer program for converting a slide show presentation for use within a non-presentation application, the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

extracting a slide title for a first slide in a slide show presentation produced by a slide show presentation application;

converting said first slide into a raster image;

disposing both said slide title and said raster image in a markup language document; and,

repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation.

17.   (Original)   The machine readable storage of claim 16, further comprising the steps of:

further extracting important text from said first slide;

annotating said raster image of said first slide in said markup language document with said extracted important text; and,

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation.

18.   (Original)   The machine readable storage of claim 17, wherein said further extracting step comprises the step of further extracting text having formatting characteristics within said first slide which emphasizes said text.

19.   (Original)   The machine readable storage of claim 18, wherein said formatting characteristics comprise a point size which exceeds a threshold value.

20.   (Original)   The machine readable storage of claim 17, wherein said annotating step comprises the step of generating an ALT tag with said important text in association with said raster image in said markup language document.

21.   (Original)   The machine readable storage of claim 20, wherein said generating step further comprises the step of formatting said ALT tag with additional inline indicators for facilitating an audible playback of said important text in a non-presentation application.

22.   (Original)   The machine readable storage of claim 17, further comprising the steps of:
        reducing said raster image to a size suitable for display in a pervasive device; and,
        rendering said slide title and said reduced raster image in a pervasive device display.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.